



**UNITED STATES DEPARTMENT OF COMMERCE**  
**United States Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

*CW*

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/609,073 06/30/00 MARSHALL

C ODS-9

001473 QM22/0827  
FISH & NEAVE  
1251 AVENUE OF THE AMERICAS  
50TH FLOOR  
NEW YORK NY 10020-1105

EXAMINER

ASHBURN, S

ART UNIT

PAPER NUMBER

3713

DATE MAILED:

08/27/01

*4*

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/609,073

Applicant(s)

MARSHALL ET AL.

Examiner

Steven L Ashburn

Art Unit

3713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-56 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-56 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

Art Unit: 3713

## **DETAILED ACTION**

### **SPECIFICATION**

Claim 16 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim, or amend the claim to place the claim in proper dependent form, or rewrite the claim in independent form. The claim describes recording a live event in real-time. Doing otherwise would be impossible because the rate of time is immutable. Consequently, the claim fails to further limit the parent claim.

### **CLAIM REJECTIONS - 35 USC § 112**

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 17 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 17 describes recording a live event after it has taken place. Due to the immutable progression of time, it is impossible to record an event that occurred in the past.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim states, "automatically providing the user with an option to record the given while the user

Art Unit: 3713

is interacting with the plurality of wager creation options ...". The claim omits a word rendering it indefinite.

#### DOUBLE PATENTING

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thornton*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1- 56 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-132 of U.S. Patent 5,830,068 to Brenner et al. in view of U.S. Patent 5,752,159 to Faust et al. Although the conflicting claims are not identical, they are not patentably distinct from each other. Brenner discloses a networked, interactive, off-track wagering system that allows a user to gather race information, place a wager, and view a race at a remote terminal. Brenner describes all of the features of the claimed invention except the following:

- a) Storing a race in a personal archive. (Claims 4, 30, 46, 56)
- b) Storing personal archive at user equipment. (Claims 5, 31)
- c) Storing personal archive at a location remote from the user equipment. (Claims 6, 32, 45)
- d) Viewing previously recorded races stored in the personal archive. (Claim 7, 46, 47)

Art Unit: 3713

- e) Listing recorded races according to track, number, or date. (Claims 8-10, 33-36)
- f) Recording the race with a digital video recorder. (Claims 13, 39, 42, 51)
- g) Allowing a user to search and display racing videos stored in a video archive. (Claims 20, 47, 49)
- h) Searching for racing videos based on search criteria including track name, conditions, jockey, horse, trainer, date, or distance. (Claims 21-29, 49, 55)

Although the features listed above are not disclosed by Brenner, they are known in the art. In short, the claimed invention modifies Brenner by providing digital storage of racing videos. Both general knowledge and prior references in the art suggest using digital recording to replace analog recording to provide improved means of file management, storage and interactivity.

It is common to transfer digital multimedia data files between a server and remote terminals over a computer network. Typical applications include multimedia files transferred over the Internet and on-demand video provided over digital broadcast television. The advantages of digital recording over analog methods are well known. Most notably, digital multimedia data files can be stored and transferred in the same manner as any computer readable data file. It would be obvious to one skilled in the art to employ digital data files in replacement of analog recordings.

It is well known in networked systems to store data files at either a server or a remote terminal. The storage location is a matter of design choice depending on a system's requirements and limitations (e.g. cost, storage capacity, network bandwidth, ergonomics, etc.). It is common to store data files in databases or lists which allow keyword searching of file contents (e.g. subject, time, date, context, keywords, etc.). Furthermore, in remote terminals containing sufficient storage capacity, it is common for remote users to transfer data files from servers into personal archives.

Art Unit: 3713

The patent to Faust, for example, discloses a method for automatically collecting and distributing multimedia data files over an interactive, broadband network comprised of a variety of consumer electronic devices. (See 3:14-21.) The system maintains a custom library of multimedia files and provides means for managing the library including cataloging and keyword searches. (See 4:57-65.)

It would have been obvious to one skilled in the art at the time of the invention to modify the interactive, off-track wagering system disclosed by Brenner to offer race videos using digital recordings stored in personal archives. As suggested by Faust, the resulting system would provide an improved means for storing, managing, locating, and transferring of race videos formally stored on magnetic tape.

#### **CLAIM REJECTIONS - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,411,258 to Wilson et al in view of U.S. Patent 5,752,159 to Faust et al. The patent to Wilson discloses an interactive video horse racing game that incorporates pre-recorded video of races to recreate live, off-track wagering. The system provides a graphic user interface that allows players to view a race form, select a race, create a wager, and view video of a race downloaded from a library of race videos. Wilson describes all of the features of the claimed invention except for the following:

- a) Allowing a user the option to automatically record a race and providing a "yes" or "no" selection . (Claims 1, 2, 3, 19, 37, 48 )

Art Unit: 3713

- b) Storing a race in a personal archive. (Claims 4, 30, 46, 56)
- c) Storing personal archive at user equipment. (Claims 5, 31, 49)
- d) Storing personal archive at a location remote from the user equipment. (Claims 6, 32, 45, 49)
- e) Viewing previously recorded races stored in the personal archive. (Claims 7, 46, 47)
- f) Listing recorded races according to track, number, or date. (Claims 8-10, 33-36)
- g) User equipment is television or telephone equipment (Claims 11, 15, 38, 39, 40, 44, 50-52, 54)
- h) Recording the race with a digital video recorder or videocassette. (Claims 12, 13, 39, 41, 42, 51)
- i) Charging a fee for recording a race. (Claims 18, 36)
- j) Allowing a user to search and display racing videos stored in a video archive. (Claims 20, 47, 49)
- k) Searching for racing videos based on search criteria including track name, conditions, jockey, horse, trainer, date, or distance. (Claims 21-29, 49, 55)

As seen above, Wilson an off-track wagering system providing an interactive interface and a library of pre-recorded racing data files; however, it does not suggest implementing the system on a network. Despite Wilson's deficiencies, the features listed above are either known or suggested by prior references in the art.

Employing networked devices to offer consumers interactive, off-track wagering in their homes is well known. Systems typically offer the ability to view race data, place wagers, and view races through a menu-based system. Fees for such services are commonly charged via subscription,

Art Unit: 3713

however it is also well known to charge in a pay-per-use. Furthermore, it is well known to employ computer, television, and telephonic assets as the basis for the wagering system.

It is common to transfer digital multimedia data files between a server and remote terminals over a computer network. Typical applications include multimedia files transferred over the Internet and on-demand video provided over digital broadcast television. The advantages of digital recording over analog methods are well known. Most notably, digital multimedia data files can be stored and transferred in the same manner as any computer readable data file. It would be obvious to one skilled in the art to employ digital data files in replacement of analog recordings.

It is well known in networked systems to store data files at either a server or a remote terminal. The storage location is a matter of design choice depending on a system's requirements and limitations (e.g. cost, storage capacity, network bandwidth, ergonomics, etc.). It is common to store data files in databases or lists which allow keyword searching of file contents (e.g. subject, time, date, context, keywords, etc.). Furthermore, in remote terminals containing sufficient storage capacity, it is common for remote users to transfer data files from servers into personal archives.

The patent to Faust, for example, discloses a method for automatically collecting and distributing multimedia data files over an interactive, broadband network comprised of a variety of consumer electronic devices. (See 3:14-21.) The system maintains a custom library of multimedia files and provides means for managing the library including cataloging and keyword searches. (See 4:57-65.)

It would have been obvious to one skilled in the art at the time of the invention to modify an interactive, off-track wagering system to offer race videos using digital recordings stored in personal archives. As suggested by Faust, the resulting system would provide an improved means for storing, managing, locating, and transferring of race videos.

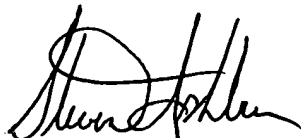
Art Unit: 3713

### CONCLUSION

The following prior art made is considered pertinent to applicant's disclosure of record, but not relied upon:

U.S. Patent 5,411,258 to Wilson et al.  
U.S. Patent 6,005,565 to Legall et al.  
U.S. Patent 6,005,561 to Hawkins et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Ashburn whose telephone number is 703 305 3543. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Martin-Wallace can be reached on 703 308 1148. The fax phone numbers for the organization where this application or proceeding is assigned are 703 305 3590 for regular communications and 703 308 3579 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 1078.



Steven Ashburn  
August 21, 2001



**MICHAEL O'NEILL**  
**PRIMARY EXAMINER**